

RECEIVED
CENTRAL FAX CENTER

FEB 12 2007

REMARKS

In his communication dated January 10, 2007, Examiner Snow alleged that Applicant "failed to make an election on the third portion of the election of species requirement defining the device positioning." Applicant's attorney appreciates the Examiner's time on February 12, 2007 in briefly discussing this requirement and his view of an appropriate response. The following is offered to meet the Examiner's requests.

The discussion below is taken from the previous response to the election requirement, and is repeated here for the Examiner's convenience and consideration. In addition, the device positioning exemplified in FIG. 3A is elected, with traverse on the grounds indicated below concerning other election requirements. The Examiner is correct to note that FIG. 3A show a posterior approach, and a change has been made accordingly to the previously-offered response. To summarize the remarks that follow for the Examiner's convenience, method claims 1-34 are chosen in response to the restriction requirement. In response to the election criteria, the system of FIG. 1 (to the extent material to method claims), a posterior approach, and a device position exemplified in FIG. 3A and others is chosen. It is believed that at least claims 1, 2, 6-30 and 33-34 read on that subject matter. These choices are made with traverse, as further discussed below.

In the prior Office Action, Examiner Snow withdrew his previous restriction requirement. A new restriction requirement has been made, however, and for at least the reasons given below, withdrawal of this requirement is respectfully requested.

In this new requirement, Examiner Snow differentiated between the following groups of claims:

RESPONSE TO PTO COMMUNICATION
Application Serial No. 10/717,684
Atty. Docket No. 4002-3269
Page 2 of 8

- I. Claims 1-34, drawn to method for intervertebral stabilization, classified in class 623, subclass 17.11.
- II. Claims 35-71, drawn to a system for stabilizing a spinal column segment, classified in class 623, subclass 17.12.

The above language concerning the groups is taken verbatim from the Office Action for clarity's sake, and is not an admission of any sort as to the subject matter or classification of any claim.

As the restriction requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, per standard PTO practice noted in MPEP 803 and 808.02 this application should be examined as a whole if it can be done without undue burden on the examiner. Thus, Applicant elects Group I (claims 1-34) for prosecution, with traverse on the ground that searching and examining the entire application can be made without serious or significant additional burden. It is understood that each claim or set of claims has a certain burden on the examiner, including searching the relevant art, considering whether the claim(s) are allowable in light of that art and the framework of section 112, and preparing an analysis setting forth the examiner's conclusions. If the burden relating to a second, third or other additional claim or set of claims is not materially greater than the burden relating to the first, then there is no undue burden involved in examining those additional claim(s). Respectfully, the existence of 71 claims and 77 figures in an application does not automatically mean that examination of all of them will be unduly more burdensome than examining a smaller set. Rather, practicalities searching and likenesses among the claims should be the evidence for whether a restriction requirement is made.

The Office Action suggests that the claim groups are related as product and process of use, and that the claims are classified in the same class and in subclasses that are immediately

RESPONSE TO PTO COMMUNICATION
Application Serial No. 10/717,684
Atty. Docket No. 4002-3269
Page 3 of 8

next to each other in the PTO classification. Assuming that product/process assessment to be true, then all of the searching relevant to the product will also be relevant to the process, and vice versa. Respectfully, most or all of the searching required for group II will be the same as that for group I, and will cover both of the subclasses identified by the examiner, which are very closely related. Such searching and consideration will be required for proper examination of both sets of claims. Thus, not only will the search subclasses be substantially or completely identical for both sets of claims, but the references sought in those subclasses will be at least highly similar, if not identical. In other words, most or all of the references, if any, that are relevant to one set of claims will likely be relevant to the other set of claims. Since the research and analysis effort required for examining one set of claims will be essentially the same as for examining both sets of claims, it is respectfully submitted that there can be no significant extra burden in searching and examining both sets of claims. Per MPEP 803 and 808.02, the restriction requirement should be withdrawn and all pending claims should be examined.

The pending Office Action also made a requirement for election of species, which is also traversed. Examiner Snow indicated the opinion that this application "contains claims directed to the following patentably distinct species of systems"

- | | | |
|--------------|---------------|----------------|
| 1) figure 1 | 6) figure 22 | 12) figure 35A |
| 2) figure 9A | 7) figure 23 | 13) figure 38A |
| 3) figure 13 | 8) figure 29 | 14) figure 41A |
| 4) figure 15 | 10) figure 33 | 15) figure 44A |
| 5) figure 21 | 11) figure 34 | 16) figure 48A |

RESPONSE TO PTO COMMUNICATION
Application Serial No. 10/717,684
Atty. Docket No. 4002-3269
Page 4 of 8

The above language is taken verbatim from the Office Action for the sake of clarity, including the omission of a number 9. It is not intended as an admission of any sort as to the subject matter or classification of any claim.

The Examiner further stated that one of the following "patently distinct approaches" must be chosen:

- 1) posterior 2) anterior 3) posterior-lateral 4) lateral

as well as a "single device position as shown in the elected system figure (from above) or a separate single figure," and provided "examples of different positions" as follows:

- 1-1) figure 18 1-3) figure 20 1-5) figure 44A
1-2) figure 19 1-4) figure 41A

The above language is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort as to the subject matter or classification of any claim.

The pending Office Action gave only the conclusory statement that the alleged species "are independent or distinct because the embodiments vary in structure, function, and/or capabilities; they have patentably distinct elements." In order to make a proper election requirement, however, "[t]he particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate." MPEP 808.01 (emphasis added). Moreover, "[w]here there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction." MPEP 808.01(a).

RESPONSE TO PTO COMMUNICATION
Application Serial No. 10/717,684
Atty. Docket No. 4002-3269
Page 5 of 8

Respectfully, the Office Action falls short. All it gives are the merely conclusory statements that the supposed species "vary in structure, function and/or capabilities" and they "have patentably distinct elements." These statements do not provide the required discussion of the relationship of the alleged species and reasons to support the conclusion. Indeed, the first statement does not identify whether it is structure, function or capability that the Office Action relies on, and neither statement gives any example or other basis for the conclusion. No citation to the application, discussion of embodiments, or other evidence or grounds for that conclusion was provided. Further, there is no evidence that the Office Action considered whether generic claims were in the application. Without that assessment, a conclusion as to distinctness of species cannot be drawn. As noted above, the MPEP defines as inadequate the conclusion of restrictability without basis, and the Office Action does not discuss those relationships or provide any reasons why they do not prevent restriction. For at least these reasons, the election requirement does not meet the required threshold, and should be withdrawn.

Additionally, the Office Action relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, in requesting that Applicant elect a single species. Section 121 permits limitation to a "reasonable number" of species. The embodiments shown and described in this application are a reasonable number for consideration, and the election requirement does not suggest otherwise. Further, the similarities among the embodiments are such that they can all be efficiently considered together when the claims are searched and examined. If "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions." MPEP 808.02. The Office Action does not allege that the classification of the

RESPONSE TO PTO COMMUNICATION
Application Serial No. 10/717,684
Atty. Docket No. 4002-3269
Page 6 of 8

alleged species is different, and it seems likely that all such species would be commonly classified. It also does not suggest that a different field of search would be required. It is not apparent from the record that any searching would be necessary for one species "that is not likely to find art pertinent to the other[s]." Id. Rather, it is believed that any practical and reasonable search strategy for one species would find references pertinent to all species. Finally, no suggestion was provided that the alleged species would be separately classified or searchable in the future. No patents or other evidence of a separate field of search was provided, as MPEP 808.02 requires. A proper election requirement "must show by appropriate explanation" (1) separate classification, (2) separate status in the art, or (3) a different field of search. Id. Because the Office Action does not provide the necessary evidence and explanation, the election requirement should be withdrawn.

The Office Action's request for a listing of the pending claims that read on the provisionally-elected species is respectfully objected to as improperly devolving the responsibilities of the PTO onto the Applicants. The PTO has the burden of proof to provide evidence and a sufficient showing that claims in an application are unpatentable, or should otherwise be excluded from an application. Further, as noted above, the Office Action does not provide sufficient information for defining what would be a proper election, and thus it is not possible to ensure a proper identification of claims.

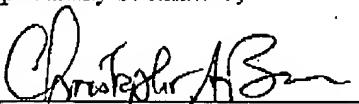
It will nevertheless be attempted to provide an election that is deemed proper so as to attempt a complete response for the sake of efficiency. Accordingly, subject matter is elected relating to figure 1, posterior approach, with traverse. As to the approach, it is respectfully submitted that has no application to the system claims. Given the breadth of the specification

RESPONSE TO PTO COMMUNICATION
Application Serial No. 10/717,684
Atty. Docket No. 4002-3269
Page 7 of 8

and the claims, it is believed that at least claims 1, 2, 6-30 and 33-34 read on that subject matter. Further, at least claims 1 and 19 among the method claims in this application, and others among the system claims, are generic to the embodiments shown in this application. Applicants do not concede the propriety of the Examiner's request, and do not intend to limit in any way the scope of the claims of this application with the statements or provisional election herein. Specifically, the claims in this application should be given the full scope permitted by their language. Applicant reserves the right to later assert that other claims read on the provisionally-elected species as well, especially if the election requirement is not withdrawn. No amendments have been made to the claims.

In conclusion, Applicant has made a provisional election as noted above with traverse. Further Office Action(s) toward a Notice of Allowance in this case are respectfully solicited.

Respectfully submitted,



Christopher A. Brown, Reg. No. 41,642
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137
Tel.: (317) 634-3456

4002-3269.CAB:445375

RESPONSE TO PTO COMMUNICATION
Application Serial No. 10/717,684
Atty. Docket No. 4002-3269
Page 8 of 8